

REMARKS

In the final Office Action, the Examiner rejects claims 1, 2, 6, 9, 10, 12, 13, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over KARVE (U.S. Patent Application Publication No. 2002/0137530) in view of PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906); rejects claim 3 under 35 U.S.C. § 103(a) as unpatentable over KARVE in view of PACKHAM et al., and further in view of GOPINATH et al. (U.S. Patent Application Publication No. 2004/0002350); rejects claim 4 under 35 U.S.C. § 103(a) as unpatentable over KARVE in view of PACKHAM et al., and further in view of DEHLIN (U.S. Patent Application Publication No. 2004/0203942); rejects claim 5 under 35 U.S.C. § 103(a) as unpatentable over KARVE in view of SABO et al. (U.S. Patent Application Publication No. 2003/0096626); and rejects claim 7 under 35 U.S.C. § 103(a) as unpatentable over KARVE in view of PACKHAM et al., and further in view of FOSTICK et al. (U.S. Patent Application Publication No. 2002/0187794). Applicants respectfully traverse these rejections.¹ Claims 1-7, 9, 10, 12, 13, 16, and 17 remain pending.

REJECTION BASED ON KARVE AND PACKHAM ETAL.

Claims 1, 2, 6, 9, 10, 12, 13, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KARVE and PACKHAM et al. Applicants respectfully traverse this rejection.

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

Independent claim 1 is directed to a method for providing SMS messages to a receiving party associated with a plurality of devices. The method includes receiving a SMS message for a first device of the plurality of devices; identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party; formatting the SMS message according to characteristics of the preferred device; and sending the formatted message to the preferred device. KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, do not disclose or suggest this combination of features.

For example, KARVE and PACKHAM et al. do not disclose or suggest identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party. The Examiner relies on paragraphs 0032-0035 of KARVE for allegedly disclosing "identifying a second device of the plurality of devices as a preferred device for receiving the SMS message based on information stored by the receiving party" and relies on paragraphs 0019-0022 of PACKHAM et al. for allegedly disclosing "instead of the first device for receiving the SMS message " (final Office Action, p. 5). Applicants object to the Examiner's piecemeal examination of the above feature of claim 1.

Claim 1 does not recite "identifying a second device of the plurality of devices as a preferred device for receiving the SMS message based on information stored by the receiving party" and "instead of the first device for receiving the SMS message." In contrast, claim 1 specifically recites "identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the

receiving party." Rather than addressing this specifically-recited feature of claim 1, the Examiner breaks the feature down into illogical parts by pointing to portions of one reference for allegedly disclosing identifying a second device of the plurality of devices as a preferred device for receiving the SMS message based on information stored by the receiving party and to unrelated portions of a second reference for allegedly disclosing instead of the first device for receiving the SMS message. Such attempts at reconstructing Appellants' claims are clearly impermissible.

Nevertheless, PACKHAM et al. is directed to a system where forwarding information is stored in a home location register (HLR) so that text messages received by a Short Message Service Gateway Mobile Switching Center (SMS/GMSC) for one device can be forwarded to a second device (see paragraphs 0019-0022). Thus, in PACKHAM et al., the SMS/GMSC performs the forwarding of text messages.

In stark contrast, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). Thus, in KARVE, the cellular telephone performs the forwarding of received SMS messages. Therefore, all SMS messages in KARVE that are for the cellular telephone (which corresponds to the first device in claim 1) must be received by the cellular telephone in order for the forwarding to take place.

Accordingly, if, as the Examiner alleges, the system of KARVE were modified to incorporate the teachings of PACKHAM et al., such a combination would result in a system that forwards text messages away from KARVE's cellular telephone before they reach the telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an

SMS message and forwards the SMS message to another number or device) inoperable. In any case, it would not result in the method recited by claim 1.

Applicants further submit that one skilled in the art would not reasonably look to incorporate PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for a first device to a second device into the KARVE system since the KARVE system is directed to actions performed by a cellular device (the first device). If one were to incorporate PACKHAM et al.'s HLR and SMS/GMSC into the KARVE system, this combination would obviate the need for the KARVE system since the forwarded destination of the text message is identified prior to reaching the first device (KARVE's cellular device).

With respect to motivation, the Examiner alleges:

it would have been obvious ... to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, p. 6). Applicants respectfully disagree with the Examiner's allegations.

As indicated above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless.

Applicants submit that one skilled in the art at the time of Applicants' invention would not have been motivated to incorporate PACKHAM et al.'s alleged disclosure of instead of the first device for receiving the SMS into the KARVE system, absent impermissible hindsight.

With respect to the above arguments, the Examiner alleges (in part):

The second criteria of a reasonable expectation of success was met since both references are from a similar field of endeavor such particularly as a method for forwarding SMS in the wireless communication system, and the combination of the two references would not be in opposition to either references' functions and operations thus resulting a reasonable expectation of success

(final Office Action, p. 2). Applicants respectfully disagree.

As set forth above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless. That is, PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for a first device to a second device would result in text messages being routed away from KARVE's cellular telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

The Examiner further alleges:

Karve clearly discloses that Karve's system is the same as Packham's system described as "SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages" (see [0007]). But, Karve does not particularly show instead of the first device for receiving the SMS message, thus there is a need for applying the teaching of Packham that instead of the first device for receiving the SMS message (fig. 1 and [0019]-[0022]) in order for people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, pp. 3-4). Applicants submit that the Examiner continues to ignore the fact that if PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for a first device to a second device were to be incorporated into KARVE's system, the result would be text messages being routed away from KARVE's cellular telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

For at least the foregoing reasons, Applicants submit that claim 1 is patentable over KARVE and PACKHAM et al., whether taken alone or in any reasonable combination.

Claims 2 and 6 depend from claim 1. Therefore, these claims are patentable over KARVE and PACKHAM et al. for at least the reasons given above with respect to claim 1.

Independent claims 9, 12, and 16 recite features similar to (yet possibly of different scope than) features described above with respect to claim 1. Therefore, Applicants submit that claims 9, 12, and 16 are patentable over KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, for at least reasons similar to reasons given above with respect to claim 1.

Claim 10 depends from claim 9. Therefore, this claim is patentable over KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 9. Moreover, this claim is patentable over KARVE and PACKHAM et al. for reasons of its own.

Claim 10 recites that the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages. The Examiner relies on

paragraphs 0007 and 0028-0029 of KARVE for allegedly disclosing this feature (final Office Action, p. 8). Applicants respectfully disagree with the Examiner's interpretation of KARVE.

At paragraph 0007, KARVE discloses:

SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages.

This section of KARVE discloses that SMS messages are sent from a sender to a recipient via an SMS Center. This section of KARVE in no way discloses or suggests an SMS server that is configured to store messages to a database when the preferred device is not available to receive messages, as recited in claim 10.

At paragraphs 0028-0029, KARVE discloses:

The telephone 10 is capable of receiving a SMS short message, also known as a Protocol Data Unit (PDU). A short message includes two parts, header information and short message text, which is also referred to as the user data. The header parameters include the address of the SMS Center to which the short message is to be sent, a Destination Address field denoting the final recipient of the short message, and the Originating Address, which is the address of the sender of the short message. The short message is sent from a mobile telephone or other device to an SMS Center. The SMS center looks at the header information, adds some additional header information, and then tries to send the user data to the recipient or destination address. The format of short messages, sending and receiving of short messages, and the operations of SMS centers are well known to those of skill in the art.

Referring now to FIG. 3, the telephone 10 includes program code for forwarding a received short message from the telephone 10 to another device or telephone. FIG. 3 is a flow diagram of a sequence of steps of such a call forwarding feature in accordance with the present invention.

This section of KARVE discloses that an SMS center looks at header information of a received short message, adds some additional header information, and then tries to send the user data to the recipient or destination address. This section of KARVE in no way discloses or suggests an

SMS server that is configured to store messages to a database when the preferred device is not available to receive messages, as recited in claim 10.

The disclosure of PACKHAM et al. does not remedy the above deficiencies in the disclosure of KARVE.

For at least these additional reasons, Applicants submit that claim 10 is patentable over KARVE and PACKHAM et al., whether taken alone or in any reasonable combination.

Claim 13 depends from claim 12. Therefore, this claim is patentable over KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 12. Moreover, this claim is patentable over KARVE and PACKHAM et al. for reasons of its own.

Claim 13 recites a feature similar to (yet possibly of different scope than) a feature described above with respect to claim 10. Therefore, Applicants submit that claim 13 is patentable over KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, for at least reasons similar to reasons given above with respect to claim 10.

Claim 17 depends from claim 16. Therefore, this claim is patentable over KARVE and PACKHAM et al. for at least the reasons given above with respect to claim 16.

For at least these reasons, Applicants respectfully request the reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 2, 6, 9, 10, 12, 13, 16, and 17 over KARVE and PACKHAM et al.

REJECTION BASED ON KARVE, PACKHAM ETAL., AND GOPINATH ET AL.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KARVE in view of PACKHAM et al., and further in view of GOPINATH et al. Applicants respectfully traverse this rejection.

Claim 3 depends from claim 1. The disclosure of GOPINATH et al. does not remedy the deficiencies in the disclosures of KARVE and PACKHAM et al. set forth above with respect to claim 1. Therefore, Applicants submit that claim 3 is patentable over KARVE, PACKHAM et al., and GOPINATH et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Moreover, this claim recites an additional feature not disclosed or suggested by KARVE, PACKHAM et al., and GOPINATH et al.

Claim 3 recites that sending the formatted message comprises sending the formatted message to an e-mail address. The Examiner admits that KARVE and PACKHAM et al. do not disclose this feature and relies on paragraphs 0054-0069 of GOPINATH et al. for allegedly disclosing this feature (final Office Action, p. 11). Applicants respectfully disagree with the Examiner's interpretation of GOPINATH et al.

At paragraphs 0054-0069, GOPINATH et al. discloses that a user may instruct that his contact e-mail be sent to the recipient of a short message (SM) (paragraph 0054) and that a database 700 includes a field 820 that stores profile information for a member, such as phone number or e-mail address of the member (paragraph 0069). GOPINATH et al. does not disclose or suggest that sending a formatted message includes sending the formatted message to an e-mail address, as recited in claim 3. Sending an e-mail address, as disclosed by GOPINATH et al., is not equivalent to sending a formatted message to an e-mail address, as recited in claim 3.

With respect to the above arguments, the Examiner alleges:

Gopinath shows specifically that "a user may instruct through his SM that his contact email be sent to the recipient of the SM by just typing the keyword 'myemail' in his SM" (see [0054]-[0069]). Thus Gopinath discloses sending a SMS to an e-mail address

(final Office Action, p. 4). Applicants respectfully disagree.

Contrary to the Examiner's allegation, GOPINATH does not disclose or suggest that sending an e-mail to an SM recipient is equivalent to sending a formatted message (which is recited as an SMS message that has been formatted according to characteristics of the preferred device) to an e-mail address, as recited in claim 3.

For at least these additional reasons, Applicants submit that claim 3 is patentable over KARVE, PACKHAM et al., and GOPINATH et al., whether taken alone or in any reasonable combination.

For at least these reasons, Applicants respectfully request the reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claim 3 over KARVE, PACKHAM et al., and GOPINATH et al.

REJECTION BASED ON KARVE, PACKHAM ETAL., AND DEHLIN

Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KARVE in view of PACKHAM et al., and further in view of DEHLIN. Applicants respectfully traverse this rejection.

Claim 4 depends from claim 1. The disclosure of DEHLIN does not remedy the deficiencies in the disclosures of KARVE and PACKHAM et al. set forth above with respect to claim 1. Therefore, Applicants submit that claim 4 is patentable over KARVE, PACKHAM et al., and DEHLIN, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

For at least these reasons, Applicants respectfully request the reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claim 4 over KARVE, PACKHAM et al., and DEHLIN.

REJECTION BASED ON KARVE AND SABO ET AL.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KARVE in view of SABO et al. Applicants respectfully traverse this rejection.

At the outset, Applicants submit that the rejection of claim 5 continues to be improper. Claim 5 depends from claim 1. Therefore, any rejection of claim 5 must be based on at least the references relied on in rejecting claim 1. The Examiner rejects claim 1 under 35 U.S.C. § 103(a) as allegedly unpatentable over KARVE in view of PACKHAM et al. Therefore, the rejection of claim 5 must be based on at least KARVE and PACKHAM et al. Since the rejection of claim 5 does not include the PACKHAM et al. reference, the rejection of this claim is improper.

Nevertheless, the disclosure of SABO et al. does not remedy the deficiencies in the disclosures of KARVE and PACKHAM et al. set forth above with respect to claim 1. Therefore, Applicants submit that claim 5 is patentable over KARVE, PACKHAM et al. and SABO et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

For at least these reasons, Applicants respectfully request the reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claim 5 over KARVE (alone or in combination with PACKHAM et al.) and SABO et al.

REJECTION BASED ON KARVE, PACKHAM ETAL., AND FOSTICK ET AL.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over KARVE in view of PACKHAM et al., and further in view of FOSTICK et al. Applicants respectfully traverse this rejection.

Claim 7 depends from claim 1. The disclosure of FOSTICK et al. does not remedy the deficiencies in the disclosures of KARVE and PACKHAM et al. set forth above with respect to claim 1. Therefore, Applicants submit that claim 7 is patentable over KARVE, PACKHAM et al., and FOSTICK et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1.

For at least these reasons, Applicants respectfully request the reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claim 7 over KARVE, PACKHAM et al., and FOSTICK ET AL.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: September 28, 2007

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